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EXAMINER

BERCH, MARK L

ART UNIT

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1624

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

The amendment filed 02/19/2008 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment raises new issues that would require further consideration and/or search.

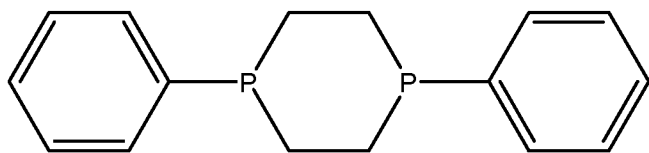
The new claim language in claim 18 specifies a “bridging group between the CO group and R41”. However, the formula shows the CO attached directly to the CO. It thus does not make provision for the CO and R41 to be not directly connected. Hence, it would raise a 35 USC 112 paragraph 2 issue.

Applicants may attempt to get around this problem by adding a second formula to accommodate the situation where the CO and the R41 are not directly connected. In drawing such a formula, applicants must make sure that there is descriptive support. If the spec teaches that any bridging group can be used with any such diphosphine, then such language could be used. But if the specification teaches less than that, then the claim language must be limited accordingly.

The amendment would have returned to the previous “ditertiary diphosphine” language. This in turn would return matters to the previously described ambiguities in this language. In this regard, applicants have stated that it means $R_2P-R-PR_2$, where R is a hydrocarbyl group, and to support this applicants have: “according to IUPAC nomenclature under phosphines, tertiary phosphines are characterized by the structure R_3P , wherein R means a hydrocarbyl group.” It might well be helpful to use this language in the claims, instead of the proposed language, since the language would then reflect applicants’ intention. However, this approach has its own difficulty. As was stated previously: “If a

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phosphine is R_3P , wherein R means a hydrocarbyl group, then neither P atoms in $R_2P-R-PR_2$ qualifies, since each P has two hydrocarbyl groups, and a third group, the $-R-PR_2$, which is not a hydrocarbyl group, since a hydrocarbyl group has just H and C. Similarly claim 18 makes reference to the phosphine having N as a point of attachment, which is inconsistent with the phosphine meaning means $R_2P-R-PR_2$, where R is a hydrocarbyl group. It would be helpful in this regard for applicants to indicate where this means $R_2P-R-PR_2$ formula came from. As the examiner has pointed out, while that formula has one bridge and two terminal groups, one could have chosen a compound with two bridges and one terminal group, e.g.:



(diphenyl diphosphacyclohexane), or, alternatively, two terminal groups and no bridge, for example, $(Methyl)_2P-P(methyl)_2$. It is understood that applicants do not intended these two types to fall within “ditertiary diphosphine”. But it is not clear at all why the proposed claim language would not embrace that.

With regard to heterocycloaliphatic, applicants have a reasonable interpretation. But the notion of the term denoting a ring which is substituted by a heteroatom is also reasonable. As evidence there is cited Watson et al, which says in paragraph 0034 “particular examples of heterocycloaliphatic groups include optionally substituted cyclobutanonyl, cyclopentanonyl, cyclohexanonyl...”, which are cycloaliphatic groups substituted by the O heteroatom. Applicants need to select an unambiguous term which reflects their intention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/
Primary Examiner
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3/21/2008

